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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,520	06/27/2001	James P. Kardach	42390P11689	5997

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EXAMINER

NGUYEN, KIMBERLY D

ART UNIT PAPER NUMBER

2876

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/894,520

Applicant(s)

KARDACH, JAMES P.

Examiner

Kimberly D. Nguyen

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6, 8-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-16 and 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Amendment*

1. Acknowledgment is made of Amendment and Request for Continued Examination filed March 27, 2006.

### *Claim Objections*

2. Claim 6 is objected to because of its dependency on claim 5, which has been canceled by applicant. Appropriate correction is required. For the purpose of examination, claim 6 is treated as a dependence of independent claim 1.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6, 8-16 and 18-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Fahraeus (US 6,502,756).

Re claims 1-2, 8, 11-14, 18 and 21-24: Fahraeus teaches a method comprising receiving a piece of paper (sheet 1 in fig. 1) having a printed pattern (4, 5, 6a, 6b in fig. 1; col. 8, lines 10-22; col. 7, lines 41-65) thereon; printing a hardcopy representation of an electronic application on the paper (i.e., printing a MENU on sheet 1 as shown in figs. 2 and 9; col. 18, line 66 through col. 19, line 4), the hardcopy representation (i.e., the MENU) having identification information (3 in fig. 9) to

associate the printed pattern (4, 5 in fig. 9) with the electronic application (i.e., the menu application), the identification information (3) comprising an identification icon (i.e., the alternatives, such as, “Vegetable Soup,” “Smoked Salmon Toast,” “Veal Oscar,” etc. as shown in fig. 9) unique to the electronic application (col. 20, lines 1-10);

recording one or more edits made with a pen (11 in fig. 6) on the hardcopy representation by recording movements of the pen with respect to the printed pattern (e.g., “If, for example, the customer orders two smoked salmon toasts, a two is written in front of the smoked salmon toast alternative...” col. 19, line 58 through col. 20, line 10; col. 17, line 49 through col. 18, line 60);

automatically sending the one or more edits made on the hardcopy representation, via wireless transmission, to a computer system (e.g., “If, for example, the customer orders two smoked salmon toasts, a two is written in front of the smoked salmon toast alternative. The two is recorded digitally by means of the device and is transferred to the kitchen...” col. 19, line 58 through col. 20, line 10; col. 18, lines 23-59); and

incorporating the one or more edits into an electronic version of the hardcopy representation (e.g., The customer’s order is recorded digitally by means of the device and is transferred to the kitchen.)

Re claims 3-4 and 15-16: Fahraeus teaches recording the identification information comprises making a mark with the pen in the area with the identification information (col. 19, lines 58-67).

Re claims 9 and 19: Fahraeus teaches the identification information (e.g., the “MENU” in fig. 9) is on the paper at a location that does not include any portion of the printed pattern (5 in fig. 9).

Re claims 10 and 20: Fahraeus teaches the field (3) comprising a pattern of dots.

### *Response to Arguments*

5. Applicant's arguments filed May 27, 2006 have been fully considered but they are not persuasive.

6. In response to applicant's argument that

“Fahraeus does not disclose incorporating the number of dishes noted by the customer into an electronic version of the menu. In fact, it would not have been practical for the restaurant to allow every customer to edit the menu...” (see page 8, last 6 lines)

the examiner respectfully disagrees with the applicant and submits that, for example, if the customer orders two smoked salmon toasts, a two is written in front of the smoked salmon toast alternative and is recorded digitally into the computer then is transferred to the kitchen (col. 19, lines 62-65). That is “the two is recorded digitally,” which is interpreted as “incorporating the one or more edits into an electronic version” as set forth in the claim(s). Accordingly, given its broadest reasonable interpretation, Fahraeus meets the claimed limitations.


### *Conclusion*

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D. Nguyen whose telephone number is 571-272-2402. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
KDN  
July 7, 2006